



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/233,694 01/19/99 BRENNEN

R 5000-0016

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LEGAL DEPARTMENT
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IM22/0522

EXAMINER

YOUNG, C

ART UNIT

PAPER NUMBER

1756

DATE MAILED:

05/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/233,694

Applicant(s)

Brennen et al.

Examiner

Young

Group Art Unit

1756

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5/2/00
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-76 is/are pending in the application.
- Of the above claim(s) 1-22, 28, 47, 51 + 70 - 76 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 23-27, 29-46, 48-50 + 52-69 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-76 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2 ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

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1. This Office action is responsive to the election (Paper No. 4) filed May 2, 2000 wherein the claims of Group II, 23-70 were elected for prosecution in the instant application. Additionally, the species "subtractive method" was elected for prosecution in the instant application with claims 23-27, 29-46, 48-50 and 52-69 being generic or drawn to the elected species. Claims 1-22 and 71-76 stand withdrawn by the Examiner as being part of the non-elected inventions. Additionally, claims 28, 47, 51 and 70 stand withdrawn by the Examiner as being part of the non-elected species.

2. The traverse of the restriction requirement in the remarks of the amendment has been carefully considered but is not deemed to be persuasive for the reasons of record as set forth in the restriction requirement of the last Office action, Paper No. 3 in combination with the following remarks.

Applicants' traversal is based on the assertion that the Examiner has not provided a showing that the process can be used to make another and materially different product or that the product as claimed can be made by another and materially different process. However, the Examiner is not required to provide a showing of this basis when the claims in the instant application are clearly drawn to different types of additive and subtractive processes that are clearly capable of supporting separate patents while being independent and distinct.

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Additionally, applicants assert that the Examiner has not made a prima facie showing of a serious burden for restriction with respect to the groups or different species by any means recited in the MPEP. It is further asserted that the Examiner has not even attempted to do so. The Examiner is not required to provide basis for serious burden during an initial restriction requirement, however, in view of applicants' assertion that the serious burden is not present in the instant application, the Examiner points out that multiple subclasses that are drawn to strictly subtractive processes will be searched in the instant application and inclusion of the additive processes would require an undue burdensome search by adding at least 10 additional subclasses, not to mention consideration of additive process claim embodiments as opposed to subtractive process claim embodiments for the elected species. Additionally, the elected substrates of the Group II invention fall out in a specific area of the Class 430 schedule while the replication method and process of producing textured surfaces fall in different subclasses that are not required for the search and consideration of the textured substrates which would further burden the Examiner for the consideration of the instant application.

The restriction requirement and species election requirement as made in the previous Office action are repeated and made FINAL.

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 23-27, 29-46, 48-50 and 52-69 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either one of Swedberg et al. or Kaltenbach et al.

The scope of the protection sought through the instant application is drawn to a high-surface area textured substrate prepared by a subtractive process to produce the high-surface area texturing of the surface. It is further recited that laser-

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ablation of the substrate is the preferred method (as claimed) for performing the subtractive process.

In view of the broad scope of the protection sought, the two references relied upon by the Examiner clearly anticipate and/or render the scope of the protection sought prima facie obvious. The scope of the broad claims is rendered as anticipated since laser ablative techniques are shown within the metes and bounds of these documents thus providing a high surface texturing of the substrate through a subtractive process.

The Examiner relies on the 35 U.S.C. § 103 rejection of prima facie obviousness since all specific dependent claim limitations may not be specifically pointed out or distinctly claimed within the metes and bounds of the documents, but would be prima facie obvious modifications to the generic teachings absent objective evidence of high probative value to the contrary. Furthermore, it is not apparent what, if any, differences exist between the prior art relied upon by the Examiner and the scope of the claims elected and prosecuted in the instant application. In a case such as this wherein features may be inherent to the documents relied upon by the Examiner, a combination rejection under 35 U.S.C. § 102/103 is proper.

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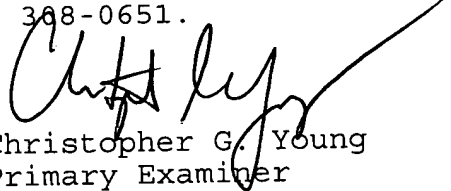
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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Young, whose telephone number is (703) 308-2984. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharon Gibson, can be reached on (703) 308-4552. The fax telephone number for this group is (703) 305-3599.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



Christopher G. Young
Primary Examiner
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C. Young:cdc
May 18, 2000